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APPLICATION NO.	į i	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/626,326		07/26/2000	William G. Hubbard	047542/0197	8619	
27433	7590	04/04/2005		EXAMINER		
FOLEY &	LARDN	ER	AZPURU, CARLOS A			
321 NORTH SUITE 2800		STREET	ART UNIT	PAPER NUMBER		
CHICAGO,		10-4764	1615			
				DATE MAILED: 04/04/200	5	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary    Carlos A. Azpuru		Application No		Applicant(s)	
Examiner   Carlos A Azpuru   Carlos A Azpuru   Total	·			HUBBARD ET A	L. <del></del>
Carlos A Azpuru  - The MAILING DATE of this communication appears on the cover sheet with the correspondence address ind for Reply  A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. THE period for reply specified show in less than 8 lays (3) 46yr., self-ship) within the authory minimum at thirty (30) 49yr will be considered finely. The period for reply specified show in less than 8 lays (3) 46yr., self-ship) within the authory minimum at thirty (30) 49yr will be considered finely. The period for reply specified show in less than 8 lays (3) 46yr., self-ship) will be authory minimum at thirty (30) 49yr will be considered finely. The period for reply specified show in less than 8 lays (3) 46yr., self-ship ship ship ship ship ship ship ship	Office Action Summary			Art Unit	
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THE MALINGS DATE OFF  Editarions of time may be available under the provisions of 37 CPR 1.136(a). In no event, however, may a rely be always with the considered timely.  In the 300 (b) for reply specified show is less than thirty (30) days, a fact with a statisty midlarium of thirty (30) days will be considered timely.  If the considered timely will be and the statistic manual or provision of the considered timely.  If the considered timely will be and or detardiating date of this communication, the statisty midlarium of thirty (30) days will be considered timely.  Failure to reply verified the said or detardiation of the considered timely.  Failure to reply will be and or detardiation of the considered timely.  Failure to reply will be and or detardiation of the considered timely.  Failure to reply will be and or detardiation of the considered timely.  Failure to reply will be and or detardiation of the considered timely.  Failure to reply will be and or detardiation of the considered timely.  Failure to reply will be and or detardiation.  This action is FINAL. 2b) ∑ This action is non-final.  Since this application is in condition for allowance except for formal matters, prosecution as to the ments is closed in accordance with the practice under Exparte Quayle, 1935 C.D. 11, 453 O.G. 213.  Sisposition of Claims  4) ∑ Claim(s)	riod for Reply	VIC SET TO E	PIRE 3 MONTH	I(S) FROM	
Responsive to communication(s) filed on	THE MAILING DATE OF THIS COMMITTEE.  - Extensions of time may be available under the provisions of 37 CFR 1.  - after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a rep.  - If NO period for reply is specified above, the maximum statutory period.  - Failure to reply within the set or extended period for reply will, by statute.  - Failure to reply within the set or extended period for reply will.	136(a). In no event, he ply within the statutory is I will apply and will exp	wever, may a reply be t ninimum of thirty (30) do re SIX (6) MONTHS fro	ays will be considered tin m the mailing date of this	nely. s communication.
Responsive to communication(s) filed on					
4a) Of the above claim(s) is/are allowed.  5) □ Claim(s) is/are allowed.  6) □ Claim(s) is/are allowed.  7) □ Claim(s) is/are objected to.  8) □ Claim(s) is/are objected to.  8) □ Claim(s) are subject to restriction and/or election requirement.  Application Papers  9) □ The specification is objected to by the Examiner.  10) ☒ The drawing(s) filed on _26 _July _2000 is/are: a) ☒ accepted or b) □ objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) □ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) □ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) □ All b) □ Some * c) □ None of:  1. □ Certified copies of the priority documents have been received.  2. □ Certified copies of the priority documents have been received in Application No  3. □ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  Attachment(s)  1) ☑ Notice of References Cited (PTO-892)  Paper No(s)/Mail Date  Paper No(s)/Mail Date  Paper No(s)/Mail Date  5 □ Notice of Informal Patent Application (PTO-152) holice of Unformal Patent Application (PTO-152) holice of Un	1) Responsive to communication(s) filed on 2a) This action is <b>FINAL</b> . 2b) ☐ This action is <b>FINAL</b> .	is action is non- rance except for	formal matters, I	prosecution as to 453 O.G. 213.	the merits is
4) ○ Claim(s) 1-41 and 57-64 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) □ Claim(s) is/are allowed. 6) ○ Claim(s) is/are objected. 7) □ Claim(s) is/are objected to. 8) □ Claim(s) are subject to restriction and/or election requirement.  Application Papers  9) □ The specification is objected to by the Examiner. 10) ○ The drawing(s) filed on 26 July 2000 is/are: a) ○ accepted or b) □ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) □ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) □ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) □ All b) □ Some * c) □ None of: 1. □ Certified copies of the priority documents have been received. 2. □ Certified copies of the priority documents have been received in Application No 3. □ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  Attachment(s) 1) ○ Notice of References Cited (PTO-892) 2 □ Notice of Oratisperson's Patent Drawing Review (PTO-948) 3 □ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 5 □ Notice of Informal Patent Application (PTO-152) 1 □ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 6 □ Other:	Disposition of Claims				
9) ☐ The specification is objected to by the Examiner.  10) ☑ The drawing(s) filed on 26 July 2000 is/are: a) ☑ accepted or b) ☐ objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Accepted 1.85(a).  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Accepted visual accepted to by the Examiner. Note the drawing(s) is objected to by the Examiner.  Note the drawing(s) is objected to by the Examiner. Note the drawing(s) is objected to. See 37 CFR 1.85(a).  Paper Note of Draftsperson is patent Drawing Review (PTO-948)    1) ☑ Notice of References Cited (PTO-892)   Notice of Draftsperson's Patent Drawing Review (PTO-948)   2) ☐ Notice of Informal Patent Application (PTO-152)   Other:	4a) Of the above claim(s) is/are without 5) ☐ Claim(s) is/are allowed.  6) ☒ Claim(s) <u>1-41, 57-64</u> is/are rejected.				
10) ☐ The drawing(s) filed on 26 July 2000 (strafe: a) ☐ accepted of b) ☐ Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12 ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) ☐ All b) ☐ Some * c) ☐ None of:  1. ☐ Certified copies of the priority documents have been received.  2. ☐ Certified copies of the priority documents have been received in Application No  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  Attachment(s)  1) ☑ Notice of References Cited (PTO-892)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  Pager No(s)/Mail Date  5) ☐ Notice of Informal Patent Application (PTO-152)  Notice of Informal Patent Application (PTO-152)	Application Papers				
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) Of (f).  a) All b) Some * c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  Paper No(s)/Mail Date  5) Notice of Informal Patent Application (PTO-152)  6) Other:	10)⊠ The drawing(s) filed on <u>26 July 2000</u> is/are:  Applicant may not request that any objection to	the drawing(s) be	t if the drawing(s)	is objected to. See	37 CFR 1.121(d).
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) Of (f).  a) All b) Some * c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  Paper No(s)/Mail Date  5) Notice of Informal Patent Application (PTO-152)  6) Other:	Priority under 35 U.S.C. § 119				
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U.S. Patent and Trademark Office Office Action Summary Part of Paper No./Mail Date 03312005	1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-9-3) Information Disclosure Statement(s) (PTO-1449 or PTO/Paper No(s)/Mail Date	48) (SB/08)	Paper No(s)  5) Notice of Inf	/Mail Date · formal Patent Applicat 	

U.S. Patent and Trademark Office PTOL-326 (Rev. 1-04)

Art Unit: 1615

## **DETAILED ACTION**

Receipt is acknowledged of the request for continued examination filed 01/18/2005.

## Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Claims 1-41 are rejected under 35 U.S.C. 102(f) as being anticipated by Hubbard (US Patent No. 6,432,437).

Hubbard disclose a polysaccharide gel which further contains a biomaterial. The composition is used for tissue augmentation (see claim 1). The polysaccharide gel comprises the same materials as those instantly claimed (see claims 3 and 4). The biomaterials are the same as those instantly claimed (see claims 9-14). The proportion of glycerin and water present in the gel is also found in claims 7 and 8. Since viscosity is determined by the amount of polysaccharide or the proportion of polysaccharide to water/glycerin, the viscosity values set out in the claims are deemed an inherent property of a composition which has already been set out in Hubbard et al.

Claims 1-41, 57-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Hubbard.

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

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under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1-41 and 57-64 are directed to the same invention as that of claims 1-30 of commonly assigned US Patent No. 6,432,437. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain <u>a</u> patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in

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scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-41, 57-64 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-30 of prior U.S. Patent No. 6,432,437. This is a double patenting rejection.

Hubbard disclose a polysaccharide gel which further contains a biomaterial. The composition is used for tissue augmentation (see claim 1). The polysaccharide gel comprises the same materials as those instantly claimed (see claims 3 and 4). The biomaterials are the same as those instantly claimed (see claims 9-14). The proportion of glycerin and water present in the gel is also found in claims 7 and 8. Since viscosity is determined by the amount of polysaccharide or the proportion of polysaccharide to water/glycerin, the viscosity values set out in the claims are deemed an inherent property of a composition which has already been set out in Hubbard et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos A. Azpuru whose telephone number is (571) 272-0588. The examiner can normally be reached on Tu-Fri, 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER